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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,792	01/10/2005	Aldo Di Nicolantonio	3165	3246
7590 03/08/2006			EXAMINER	
Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743			BREAN, LAURA MICHELLE	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/520,792

Applicant(s)

DI NICOLANTONIO, ALDO

Examiner

Laura M. Brean

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/10/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “shutoff mechanism” of claim 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 3724

2. Figure 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

On page 1, line 5, the reference to the "characteristics of claim 1" should be removed from the specification.

On page 1, line 9, patent "DE 198 06 675" should be changed to --DE 198 05 675--.

On page 2, line 2, the reference to the "characteristics of claim 1" should be removed from the specification.

Appropriate correction is required.

Claim Objections

4. Claims 5, 6, 9 and 10 are objected to because of the following informalities:

In Claim 5, line 3, "the roller lever" should be changed to -- a roller lever--.

Art Unit: 3724

In Claim 6, line 3 "the roller lever" should be changed to -- a roller lever--.

In Claim 9, line 3, "the roller lever" should be changed to -- a roller lever--.

In Claim 9, line 5, "the spring element" should be changed to -- a spring element.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 7 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 7 and 8 cite that the second stop (21) can be set to various distances from the roller lever. However, it is unclear from the specification how this action is accomplished. The fourth paragraph on page 5 of the specification states that there is an adjusting knob that makes it possible to manually set the second stop to different distances, where the different distances are referred to as various vertical positions above the roller lever. However, there is no discussion of how the knob operates with respect to setting the second stop at these various vertical positions above the roller lever. It appears that the knob is shown in the drawings, but there is no reference

Art Unit: 3724

number assigned to the feature. Fig. 2 of the drawings shows what appears to be the adjusting knob connected to the second stop, but there are no secondary figures showing how the knob operates to adjust the vertical height of the second stop. It is unclear how the knob functions to change the vertical position of the second stop above the roller lever and thus how the second stop can be set at these various distances.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the spring force" in the last two lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the compression spring force" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 11, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3724

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Dürre et al.,(U.S. Patent 5,644,846), herein referred to as Dürre. Dürre discloses a motor driven compass saw machine (reciprocating jig-saw) having a housing (1) that contains a longitudinally moving lifer rod (slide, 5), which supports a saw blade (2), and an oscillating mechanism (balancing mass, 13) that is able to impart a variable oscillation stroke, which is oriented lateral to the longitudinal motion, to the saw blade (2), wherein it is possible to automatically adjust the oscillation stroke smoothly between the maximum and minimum stroke during the sawing process, as a function of the operating mode (see column 4, lines 57-67).

In regards to claim 2, Dürre discloses that the oscillation mechanism (13) has a roller lever (pivoting fork, 19) that is disposed in the housing (1) can rotate around a horizontal first axis (point of rotation, 23), and supports a roller (support roller, 21) that remains in contact with the saw blade (2) and can rotate around a horizontal second axis (center of roller 21), and whose oscillation mechanism has a fork lever (13) that periodically deflects the roller lever (19), wherein it is possible to control the oscillation stroke as a function of the pressure of the saw blade (2) against a work piece to be sawn (see columns 3,4, lines 59-67 and lines 1-8).

In regards to claim 3, Dürre discloses that the oscillation mechanism includes a spring element (not numbered, as shown in Fig 1, to the left of reference 16), that is disposed between the housing (1) and the end (upper flat surface) of the roller lever

Art Unit: 3724

(19) orientated away from the roller (21) and cooperates with a component parallel to the deflection direction of the fork lever (13).

In regards to claim 4, Dürre discloses that parallel to the spring element (not numbered), a damping device (not numbered) is disposed between the housing (1) and the end of the roller lever (19) orientated away from the roller (21). The damping device is considered the parallel, vertical member to the right of the spring that acts to dampen the oscillation of the roller lever by providing an impeding force on the top corner of the lever during spring compression.

In regards to claim 5, Dürre discloses that underneath the roller lever (19), in the region of its end orientated away from the roller (21), a first stop (sliding surface, 17) is provided on the housing (1), where the sliding surface prevents the roller lever (19) from sliding backwards.

In regards to claim 6, Dürre discloses that above the roller lever (19), in the region of its end orientated away from the roller (21) a second stop (stop limit, 26) is provided on the housing (1), shown in Figures 2-5.

In regards to claim 7, Dürre discloses that the second stop (26) can be set to various distances from the roller lever (19) via knob 25, see column 4, lines 57-67.

In regards to claim 8, Dürre discloses that the second stop (26) can be manually set to various distances from the roller lever (19) via knob 25, see column 4, lines 57-67.

Art Unit: 3724

In regards to claim 11, Dürre discloses a shutoff mechanism (latching means, 24) as shown in Figures 2-5 that is positional between positions A and B, where A represents a "shutoff" position.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dürre in view of Walton II (U.S. Patent 4,238,884), herein referred to as Walton. Dürre discloses the claimed invention, except that there is a second spring that presses the saw blade (2) against the roller (21). However attention is directed to the Walton device that discloses an orbital jig saw with a compression spring (106) that presses the saw blade against the roller via slide bearing 100. The action of the compressive spring on the slide bearing provides the saw blade positive guiding and driving control with no lost motion (column 5, lines 11-23). It would have been obvious to one having ordinary skill in the art to have provided a compression spring on the device of Dürre in view of the teachings of Walton in order to provide a positive guiding and driving control for the saw blade.

Art Unit: 3724

In regards to claim 10, Dür, as previously modified by Walton, discloses that wherein a deflection of the roller lever (19) only occurs if the advancing force of the compass saw machine is greater than the difference between the spring force and the compression spring force.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 4,628,605 to Clowers discloses a variably oscillating bayonet saw with a roller feeder. U.S. Patent 5,819,421 to Giacometti et al., U.S. Patent 5,727,322 to Giacometti, U.S. Patent 5,819,421, to Giacometti et al., U.S. Patent 4,262,421 to Bergler et al., U.S. Patent 5,205,043 to Batt et al., U.S. Patent 6,553,675 to Orrico, U.S. Patent 2,775,272 to Papworth, and U.S. Patent 5,778,538 to Gentinetta et al., all disclose jigsaws with oscillating roller feeder mechanisms.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura M. Brean whose telephone number is (571) 272-8339. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LMB
03/01/2006


STEPHEN CHOI
PRIMARY EXAMINER